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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/950,087	09/10/2001	P. Hamilton Clark III	D/A1322 (1508/3380)	2257
7590 11/04/2005			EXAMINER	
Gunnar G. Leinberg, Esq. Nixon Peabody LLP, Clinton Square P.O. Box 31051 Rochester, NY 14603-1051			STIMPAK, JOHNNA	
			ART UNIT	PAPER NUMBER
			3623	
DATE MAILED: 11/04/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/950,087

Applicant(s)

CLARK ET AL.

Examiner

Johnna R. Stimpak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/10/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a first office action upon examination of application number 09/950,087.

Claims 1-30 are pending and have been examined on the merits discussed below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-30** are rejected under **35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the word “enabling” is indefinite because it is not clear how the method is “allowing” or how the method would “not allow” the project to advance to the next phase. An alternative would be to positively recite the steps as suggested – “advancing the project to the next phase based on...” – this is just one example, there are other occurrences in the rest of the claims. Please make corrections.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-5, 7-11, 13-17, 19-21, 23-25 and 27-29** are rejected under 35 U.S.C. 102(b) as being anticipated by McAtee et al, US 5,301,320.

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As per **claim 1**, McAtee et al teaches creating at least one phase for the project (column 5, lines 25-30 – the business operations are broken down into goals each representing a business activity and further decomposed into the tasks necessary for its accomplishment); identifying which of one or more stored exit criteria are applicable to at least one of the phases of the project (column 5, lines 25-30 – the business operations are broken down into goals each representing a business activity and further decomposed into the tasks necessary for its accomplishment and column 7, lines 17-33 – each goal specifies criteria and when that goal is accomplished, the project can move on to the next task); establishing the identified one or more stored exit criteria for the at least one phase, the one or more exit criteria based at least partially on experience gained from one or more prior projects (column 5, lines 43-50 – goals are determined by the designer, stemming from a variety of considerations, inherently the goal would reflect criteria known from past experience so the tasks are completed successfully); determining whether each of the identified one or more stored exit criteria have been satisfied for the at least one phase (column 7, lines 17-33 – each goal specifies criteria and when that goal is accomplished, the project can move on to the next task); and enabling the project to advance to a next one of the phases based on the determination of whether each of the identified one or more stored exit criteria have been satisfied for the at least one phase (column 7, lines 17-33 – each goal specifies criteria and when that goal is accomplished, the project can move on to the next task).

As per **claim 2**, McAtee et al teaches modifying one or more of the identified one or more stored exit criteria to accommodate for project requirements (column 5, lines 43-50 - the designer can alter the goals to shift the relationship of the tasks to ensure the tasks are completed).

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As per **claim 3**, McAtee et al teaches enabling the project to advance if the determination indicates that at least one of the identified one or more exit criteria have been satisfied (column 7, lines 17-33 – each goal specifies criteria and when that goal is accomplished, the project can move on to the next task).

As per **claim 4**, McAtee et al teaches tracking one or more problems noted for the project (column 8, lines 31-37 – status of the project is tracked, an idle condition indicates the project has been interrupted, inherently this interruption could be due to a problem or alteration).

As per **claim 5**, McAtee et al teaches monitoring progress of portions of the at least one phase of the project related to the identified one or more stored exit criteria (column 8, lines 17-30 – status of the goals are monitored); and determining if the portions related to the identified one or more stored exit criteria have been performed, wherein the enabling is also based on the determining if the portions related to the identified one or more stored exit criteria have been performed (column 7, lines 17-33 – each goal specifies criteria and when that goal is accomplished, the project can move on to the next task).

Claims 7-11 are directed to the project management system for performing the method of claims 1-6, therefore, the same rejections as applied to claims 1-6 are also applied to claims 7-12 since McAtee et al teaches a computer system.

Claims 13-17 are directed to the computer readable medium with instructions to perform the method of claims 1-6, therefore the same rejections as applied to claims 1-6 are also applied to claims 13-18 since McAtee et al teaches a computer system

As per **claim 19**, McAtee et al teaches identifying one or more project requirements (column 5, lines 25-30 – the business operations are broken down into goals each representing a

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business activity and further decomposed into the tasks necessary for its accomplishment); creating a project strategy (column 5, lines 25-30 – the business operations are broken down into goals each representing a business activity and further decomposed into the tasks necessary for its accomplishment); defining a time schedule based on the project strategy (column 6, lines 42-45 – time restrictions are set); identifying and creating one or more project phases within the project (column 5, lines 25-30 – the business operations are broken down into goals each representing a business activity and further decomposed into the tasks necessary for its accomplishment); integrating the one or more phases with the time schedule (column 6, lines 42-45 – time restrictions are set for the goals); identifying which of one or more stored exit criteria are applicable to at least one of the phases of the project (column 5, lines 43-50 – goals are determined by the designer, stemming from a variety of considerations); establishing the identified one or more stored exit criteria for the at least one phase (column 5, lines 43-50 – goals are determined by the designer, stemming from a variety of considerations); determining whether each of the identified one or more stored exit criteria have been satisfied for the at least one phase (column 7, lines 17-33 – each goal specifies criteria and when that goal is accomplished, the project can move on to the next task); and implementing the project by enabling the project to advance to a next one of the phases based on the determination of whether each of the identified one or more stored exit criteria have been satisfied for the at least one phase (column 7, lines 17-33 – each goal specifies criteria and when that goal is accomplished, the project can move on to the next task).

As per **claim 20**, McAtee et al teaches basing the one or more exit criteria at least partially on experience gained from one or more prior projects (column 5, lines 43-50 – goals are

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determined by the designer, stemming from a variety of considerations, inherently the goal would reflect criteria known from past experience so the tasks are completed successfully).

As per **claim 21**, McAtee et al teaches tracking one or more problems noted for the project (column 8, lines 31-37 – status of the project is tracked, an idle condition indicates the project has been interrupted, inherently this interruption could be due to a problem or alteration).

Claims 23-25 are directed to the project management system for performing the method of claims 19-22, therefore, the same rejections as applied to claims 19-22 are also applied to claims 23-26 since McAtee et al teaches a computer system.

Claims 27-29 are directed to the computer readable medium with instructions to perform the method of claims 19-22, therefore the same rejections as applied to claims 19-22 are also applied to claims 27-30 since McAtee et al teaches a computer system

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 6, 12, 18, 22, 26 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over McAtee et al, US 5,301,320.

As per **claims 6, 12, 18, 22, 26 and 30**, McAtee et al does not explicitly teach making information regarding the project accessible through at least one Web page provided to one or more project participants, the information being accessible to each of the project participants

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depending on their role in the project. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the manual process shown in McAtee et al and modify it to include accessing information over the Internet; because the advantage accessing the information over the Internet allows project participants to access project data anywhere in the world that has access to the Internet.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Srinivasan, US 5,548,506 – automated, electronic network based, project management server system, for managing multiple workgroups
Schumacher, US 5,172,313 – computerized management system



9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R. Stimpak whose telephone number is 571-272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS
10/31/05



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